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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/533,115	09/25/95	HUTTON	G 649-2

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LM02/1028

EXAMINER

RINEHART, M

ART UNIT

PAPER NUMBER

2756

23

DATE MAILED:

10/28/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*See Attachment*

Mark H. Rinehart  
Primary Examiner

# Office Action Summary

Application No.  
08/533,115

Applicant(s)  
Hutton et al.

Examiner  
Mark H. Rinehart

Group Art Unit  
2756



☒ Responsive to communication(s) filed on 12/4/97 and 8/14/98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-68 is/are pending in the application.

Of the above, claim(s) 5, 12-20, 22, 25, 65, and 68 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4, 6-11, 21, 23, 24, 26-64, 66, and 67 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 5, 12-20, 22, 25, 65, and 68 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Part III DETAILED ACTION**

1. This application has been examined. Claims 1-68 are pending.
2. The amendment received on 12/04/97 has been entered. New claims 54-68 have been added.
3. The declaration filed on 12/04/97 under 37 CFR 1.131 is sufficient to overcome the Civanlar et al. (US 5,581,552) reference.

***Election/Restriction***

4. Applicant's election without traverse of Invention Group I consisting of claims 1-4, 6-11, 21, 23-24, 26-64, and 66-67 in Paper No. 22 received 08/14/98 is acknowledged.
5. Claims 5, 12-20, 22, 25, 65, and 68 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to non-elected Inventions Groups II, III, and IV. Election was made **without** traverse in Paper No. 22.

***Information Disclosure Statement***

6. In view of the extremely large number of references submitted by the Applicant(s) for consideration of this application, the Applicant(s) are requested to identify any references which have particular significance in the prosecution of this application for further consideration by the Examiner. Applicant(s) should also indicate the specific features, corresponding passages, and figures of such references which are believed to be germane to the invention claimed in the application. Applicant is reminded that mere presentation of a reference does not preclude presentation of an analysis of the reference to insure proper consideration during examination.

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***Specification***

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gordon (US 5,608,786).

Gordon teaches a system operating to establish a point-to-point connection through an internet system utilizing IP addressing and telephone connection setup based on active status response to queries of a connection database. See Abstract; Figures 1 and 5; and col. 1-3, 4-6, and 8-10. Thus, Gordon reads on the claimed method.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

11. Claims 1-4 are rejected under 35 U.S.C. § 103 as being unpatentable over Cohn, et al, (US 5,740,231) in view of Morgan, et al., (US 5,524,254).

The claimed invention found within Claim 1 consists of a method for establishing point-to-point Internet communications comprising (a) storing in a database a set of IP addresses for on-line nodes, (b) transmitting a query from a node to a server to determine the status of a second node, and © retrieving the IP address of the second node from the database in to establish communication between the two nodes. Cohn, et al., at Figures 6 and 13 and col. 15, lns. 20-63 and col. 23, ln. 29 - col. 24, ln. 42, teaches a multimedia server which uses a communication protocol in which the requesting node sends a request for communication with another node through a address server, which contains an address database, to obtain the address and routing information necessary to complete the communication. Cohn, et al., doesn't specifiy searching the database to match the address with the destination node. Morgan, et al, in columns in columns 3-4, teaches the look-up procedure into the database which is performed to retrieve the matching address from the database for use in initiating communications over an network. It would have been obvious to one of ordinary in the art at the time the claimed invention was made to include an database and search/retrieval mechanism to locate the needed network address because such a mechanism permits the database to me modified over time to allow dynamic address assignment thus reducing the need to larger address identifiers and thus the amount of data that needs to be transmitted with each packet of data.

Regarding Claim 2, the claimed invention adds the further limitation to the invention found within Claim 1 that steps of obtaining the on-line status and IP address of the second node

include the steps of: (b1) sending a query to a server, (c1) searching the server's database, (c2) determining the on-line status of the second node, (c3) retrieving the IP address of the second node, (c4) and transmitting the IP address of the second node from the server to the requesting node. As was discussed above regarding Claim 1, Morgan, et al., in columns 3-4, teaches the look-up procedure into the database which is performed to retrieve the matching address from the database for use in initiating communications over an network. It would have been obvious to one of ordinary in the art at the time the claimed invention was made to include an database and search/retrieval mechanism to locate the needed network address because such a mechanism permits the database to be modified over time to allow dynamic address assignment thus reducing the need to larger address identifiers and thus the amount of data that needs to be transmitted with each packet of data.

Regarding Claim 3 and 4, the claimed invention in Claim 3 adds the further limitation to the invention found within Claim 2 that the claimed process generate and transmit an error message which is sent to the requesting node when the second node's status is off-line. The claimed invention Claim 4 adds the further limitation to the invention found within Claim 1 that secondary communications protocol is used when a off-line status is found. Morgan, et al., in columns 13-14 teaches the process of handling error condition where the requested second node is not available, that the processing terminates gracefully. Implicit within this operation is the transmittal of appropriate messages to the requesting node of this condition with the initiation of error recovery procedures..

12. Claim 6, which teaches an apparatus claim, fail to teach or define above or beyond Claims 1-4 above and are rejected for the same reasons set forth above in the rejections of Claims 1-4, supra.

13. Claims 7-11, which also teaches a set of apparatus claims, fail to teach or define above

or beyond Claims 1-4 above and are rejected for the same reasons set forth above in the rejections of Claims 1-4, supra.

14. Claim 21, which teaches a computer program product claim, fail to teach or define above or beyond Claims 1-4 above and are rejected for the same reasons set forth above in the rejections of Claims 1-4, supra.

15. Claims 23-24, which also teaches a set of apparatus claims, fail to teach or define above or beyond Claims 1-4 above and are rejected for the same reasons set forth above in the rejections of Claims 1-4, supra.

16. Claims 26-42, 54-59, and 67, which teaches a set of method claims, fail to teach or define above or beyond the apparatus found within Claims 1-4 above and are rejected for the same reasons set forth above in the rejections of Claims 1-4, supra.

17. Claims 43-53, 60-64, and 66, which teach a set of computer program product claims, fail to teach or define above or beyond the apparatus found within Claims 1-4 above and are rejected for the same reasons set forth above in the rejections of Claims 1-4, supra.

18. Claims 5 and 25 are rejected under 35 U.S.C. 103 as being unpatentable over Cohn, et al, (US 5,740,231) in view of Morgan, et al., (US 5,524,254) as applied to claims 1-4 above, and further in view of December, et al. (The World Wide Web Unleashed) . The claimed invention in Claims 5 and 25 adds the further limitation to the invention found within Claim 4 that performing the secondary communication protocol includes (d1) transmitting an e-mail signal over Internet from the first node with its IP address, (d2) transmitting the message thru the Internet for delivery at the second node, and (d3) transmitting a second IP address to the first node for establishing the point-to-point communications. The combination of Cohn, et al., and Morgan, et al. teaches the communications mechanism claimed here in utilizing the address server and its database to initiate communications between the two nodes. Neither of these two references teaches the

message transport mechanism which is utilized to transmit the various messages between the various processors on the network. December, et al., on pages 6-9 teaches the various message and data types which are readily transported between two nodes attached to the Internet and that each type of message is a format for which blocks of data are sent between different processors. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize Internet e-mail messages as the means to transport various requests between two processors attached to the Internet because it is a well defined and well supported data transport means for moving data between processors across the Internet and that the substitution of e-mail as the transport mechanism for any other message transport means would be within the ordinary skill of the art as these transport means are equivalent means for moving blocks of data between nodes of the network.

#### ***Response to Arguments***

19. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Heylighen teaches the basics of Internet communication and the addressing means used therein.

21. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**



(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5358, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington. VA., Sixth Floor (Receptionist).

22. Any inquiry concerning this communication or earlier communications from the examiner  
should be directed to Primary Examiner Rinehart whose telephone number is (703) 305-4815.  
The examiner can normally be reached on Monday through Thursday from 8:00 AM - 5:30 PM.  
The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Supervisory Primary Examiner Frank J. Asta, can be reached on (703) 305-3817.  
The fax phone number for the Electrical Examining Technology Center is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group receptionist whose telephone number is (703) 305-3900.

Mark H. Rinehart  
Primary Examiner  
Art Unit 2756



A handwritten signature in black ink, appearing to read "Mark H. Rinehart".

**Mark H. Rinehart**  
**Primary Examiner**